

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the comments that follow.

Claims 1-6 are pending in this application. In this response, claims 1, 5 and 6 have been amended and claim 7 added. Thus, claims 1-7 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, page 5, line 28 to page 6, line 2.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over DE 3314049 to Grafe (hereafter "*Grafe*") in view of U.S. Patent No. 5,083,887 to Dotany (hereafter "*Dotany*") on the grounds set forth at page 3 of the Official Action. This rejection is respectfully traversed because the proposed combination does not identify all of the claimed features in the present claims and is therefore missing an element. See, M.P.E.P. §§2143-2143.03.

The independent claims at issue here, includes among its features that the active edges of the cutting insets of the same flute partially overlap each other in imaginary, radially extending overlapping planes. Furthermore, the body includes an even number of flutes and insert rows (in some cases, at least four or two of each type (see, e.g., claim 5)), where the front cutting insert in every second flute has another length than the other cutting inserts in the same flute. This arrangement has been shown to advantageously and unexpected improve performance of the milling tool by, among other things, producing a uniform load on the cutting inserts (see, claims 6 and 7).

Grafe discloses a tool in which several spiral flutes (3) each have an arrangement of inserts (6 and, in some instances 60) along its length. Within each flute, each of the inserts is separated by a gap (11). One flute (3) includes a front insert (60) that is longer in the axial direction than the other inserts in that row.

Dotany discloses a cutting tool in which cutting inserts are arranged in a helical flute such that the cutting edge of each insert is in overlapping relationship in the axial direction with the cutting edge of the next adjacent insert (Abstract).

From the above disclosures in *Grafe* and *Dotany*, one can see that what is missing from this combination is a disclosure of an even number of flutes and insert rows, respectively, amounting to at least four, wherein the front cutting insert in every second flute has another length than the other cutting inserts in the same flute and a disclosure of the cutting inserts arranged to subject each to a uniform load. Also, there is no reasoned statement explaining the basis for any modification of the cited references in support of an obviousness rejection of the claims as presently presented. In fact, these features, i.e, features of original claim 5 now included in claims 1 and 6 and the added feature in claims 6 and 7, have not even been addressed in the prior office action. This is improper as an obviousness rejection (*see, KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, (2007); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Thus, it is respectfully asserted that a *prima facie* case of obviousness has not been established because at least some of the claimed features are lacking from the rejection. Accordingly, withdrawal of the rejection is appropriate.

INFORMATION DISCLOSURE STATEMENT

Applicant timely submitted a copy of JP 10-291115 in an Information Disclosure Statement dated April 16, 2007. A PTO-1449 was returned to the Applicant with JP 10-291115 struck-out. Allegedly, a copy of the reference JP 10-291115 was not present in the file upon the application being taken up for examination. The Examiner's action not considering the reference JP 10-291115 is respectfully traversed because a copy of JP 10-291115 along with an Abstract was timely submitted on April 16, 2007 with the application papers.

As evidence of such submission, Applicants enclose herewith a copy of the USPTO date stamped postcard receipt from April 16, 2007, listing 5 non-US references as having been received by the USPTO. As seen on the PTO Form 1449 submitted on that date (courtesy copy attached), there are 5 non-US references listed, including JP 10-291115 along with an Abstract. Thus, Applicants have presented evidence that JP 10-291115 and an Abstract were submitted and received by the USPTO in this application.¹

Furthermore, this application is a national stage application of PCT/SE2004/001853. The reference JP 10-291115 is listed on the International Search Report of this PCT application (a copy of which was submitted on April 16, 2007) and the references cited thereon were submitted (as evidenced by the date stamped USPTO postcard). Thus, the Examiner is required to consider all of the documents from the ISR and to indication that consideration. See, MPEP § 1893.03(g). Here, such consideration would include the reference JP 10-291115. Thus, the Examiner should properly consider all of the documents listed on the ISR (including the reference JP 10-291115)

¹ A postcard receipt that itemizes and properly identifies the items that are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. See, MPEP § 503.

at least by an indication in the Office Action itself. See, MPEP §§ 1893.03(e) and (g).

Alternatively, the Examiner can indicate such consideration by including the reference JP 10-291115 on a PTO-892.

Based on the above, consideration of the reference JP 10-291115 and the Abstract is respectfully considered based on the prior timely filing. A courtesy copy of the reference and the prior submitted PTO Form 1449 is attached for the use of the Examiner. The return of an Examiner initialed PTO Form 1449 or inclusion on a PTO Form 892 is respectfully requested. No further fee for this submission is required.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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